



D-1222 R5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Graef, et al.)	
)	
Application No.: 10/797,331)	Art Unit 3654
)	
Confirmation No.: 4299)	
)	
Filed: March 9, 2004)	Primary Examiner
)	Rakesh Kumar
)	
Title: ATM Currency Presenter)	
Gate Arrangement)	

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the rejections in the above-identified application (as presented in the final Office Action dated November 17, 2006).

No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reason that the rejections are not legally valid because the applied references do not render the claims obvious.

Claim Status

Claims 2-21 are pending. Claims 2, 7, 12, and 18 are independent.

Claims 12-15 were allowed.

Claims 2-6 and 16-21 were rejected as obvious pursuant to 35 U.S.C. § 103(a) over Weigel (US 5,234,209).

Claim 7 was rejected as obvious pursuant to 35 U.S.C. § 103(a) over Weigel in view of Ebihara (US 4,787,617).

Claim 8 was rejected as obvious pursuant to 35 U.S.C. § 103(a) over Weigel in view of Ebihara and Adelberger (US 4,462,509).

Claims 9-11 were rejected as obvious pursuant to 35 U.S.C. § 103(a) over Weigel in view of Ebihara, Adelberger, and Meyer (US 5,797,599).

Argument

Evidence of record must teach or suggest the recited features. Assertions not based on evidence in the record lack substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). A determination of patentability must be based on evidence in the record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Appellants respectfully disagree with the features attributed to the references. The Office has not established a *prima facie* case of obviousness. Nor would combining references in the manner alleged by the Office have been obvious to one having ordinary skill in the art. Even if it were somehow possible (for sake of argument) to have combined the references as alleged by the Office, the result still would not have produced the recited apparatus. The applied references are devoid of any teaching, suggestion, or motivation to produce the recited apparatus.

Independent Claim 2

Claim 2 recites that "the gate is arranged to move in an upward direction during movement toward the open position". Appellants had argued, at the paragraph bridging pages 20-21 in their Response dated August 25, 2006 ("Response"), that "Weigel further does not teach a presenter gate that moves *upward* during opening. Conversely, the alleged gate (42) (i.e., the folding flap of the currency container 14) in Weigel moves downward during its opening (e.g., col. 6, lines 45-49)". The final Action did not address Appellants' argument. Nor can it, because Weigel does not teach or suggest the features attributed thereto.

Independent Claim 18

Claim 18 recites that "the gate correspondingly moves in an opening direction as each pin moves upward in a respective slot". Appellants had argued (on page 21 of their Response) that "Weigel also does not teach the recited relationship between the gate and pin, where the gate moves in an opening direction as the pin moves upward. Conversely, as the alleged pin (68) in Weigel is pulled upward, the alleged gate (42) moves to close (instead of open)". The final Action did not address Appellants' argument. Nor can it, because Weigel does not teach or suggest the features attributed thereto.

Independent Claim 7

Claim 7 recites that "the presenter includes a plurality of belts, wherein each center portion [located between tapering portions] supports a respective belt thereon".

With regard to Weigel, Appellants had argued (on page 22 of their Response) that "The relied upon structure (mechanically engaging levers) of the alleged presenter (10) in Weigel does not include or need belts" and "Where does Weigel have any roller with a belt thereon?".

With regard to Ebihara, Appellants had argued (on page 22 of their Response) that "The alleged 'plural rollers' (13) in Ebihara is actually a single accumulating wheel. Nor does the wheel (13) support a belt".

The final Action did not address Appellants' arguments. Nor can it, because neither Weigel nor Ebihara teaches or suggests the features attributed thereto.

Additional Comments

In accordance with 37 CFR § 1.111(b), the Appellants have a responsibility to point out any clear "errors in the examiner's action" (MPEP § 714.02).

The Office has not answered Appellants' arguments

Appellants respectfully submit that the final Action did not answer all of their traversals. Therefore, the Office was not in compliance with MPEP § 707.07(f) which states "Where the applicant traverses any rejection, the examiner" is to "take note of the applicant's argument and *answer* the substance of it."

The Office's obligation to document its evidence for rejection on the record is also a mandatory requirement to allow appellate review of the basis for denial of a patent. Appellants are not required to prove patentability. Rather, the burden is on the Office to establish a case of obviousness under the law. Otherwise, the Office is legally required to grant a patent.

Appellants are disappointed, as the record is best understood, that it appears they have to file an appeal just to have their prior arguments addressed (hopefully) by the Office.

The denied entry of the after final amendment is legally improper

Appellants filed an after-final amendment on January 31, 2007. The amendment merely placed the dependent claim 8 subject matter into independent claim 7. Claim 8 was canceled.

The Advisory Action dated March 21, 2007 stated that the reason for denying entry of the amendment was because it was "not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal". Appellants respectfully disagree.

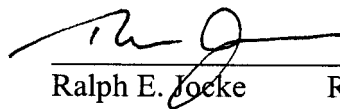
In the after-final amendment, claim 7 was made identical to previous claim 8 (the subject matter of which was already claimed and examined). Claim 8 was then canceled to avoid duplication. As a result of the amendment, the subject matter of previous claim 7 was removed from being an issue. How did this result not constitute "materially reducing or simplifying the issues for appeal"? Again, the Office provides no valid reason whatsoever for its actions.

Additionally, even an amendment after an appeal is permitted entry to rewrite dependent claims into independent form. See 37 CFR § 41.33(b)(2) and MPEP § 1206. That is, the Office would be required to enter the same after-final amendment after appeal. Thus, if after appeal (which is even later in this prosecution process than the final rejection) the Office would be required to enter the same amendment, then what legal basis does the Office have for denying its entry earlier in the prosecution process? There is none.

Conclusion

Appellants respectfully submit that all the pending claims are allowable.

Respectfully submitted,



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